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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,263	10/22/2003	D. Mark Tucker	WK/2003-12/US	5444
7590 WARD KRAFT, INC. P.O. BOX 938 FORT SCOTT, KS 66701		06/08/2007	EXAMINER BATTULA, PRADEEP CHOUDARY	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 06/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/691,263

Applicant(s)

TUCKER, D. MARK

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

This action is in reply to the amendment filed on March 23, 2007

Claim Objections

Claim 24 is objected to because of the following informalities: The Claim is identical to Claim 23. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip in view of Kelly.

In regards to Claim 1, McKillip discloses a combination label and document holder structure for shipping containers or the like, comprising: a sheet of printable material 12 (Column 5, Lines 6 – 10; Figures 1 and 3, Item 12); a non-opaque printable release liner covering a portion of said sheet 14 (Column 5, Lines 11 – 20); a layer of adhesive 18 bonding said release liner to said sheet (Column 5, Lines 11 – 13; Figure 13, Item 8); a first die cut 20 through only said sheet and adhesive layer, said first die cut defining an adhesive-backed label 22 in said sheet (Column 5, Lines 21 – 28; Figure 2, Items 20, 22; Figure 3, Items 18, 20, and 22).

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With respect to said liner carrying a message on the outside thereof; McKillip discloses that the liner 14 is a liner substrate. It is well known in the art that substrates are able to carry indicia and therefore the liner of McKillip is capable of carrying a message on the outside thereof.

McKillip does not disclose a second die cut through only said release liner outwardly of said first die cut, said second die cut defining in said release liner a frame area around a window area; so that removal of said release liner in said frame area exposes said adhesive layer in only said frame area, and that removal of said adhesive-backed label exposes an adhesive-free window area in which said message can be seen through said non-opaque release liner.

Kelly discloses an adhesive label 30 for a carton 20 (Column 7, Lines 7 – 10) having a first die cut 60 only through said sheet and adhesive layer (Column 8, Lines 12 – 16; Figure 7, Items 30, 60) which defines a label which therefore through only said sheet and adhesive (Column 8, Lines 14 – 15) and a second die cut 58 through only said release liner outwardly the first die cut and defining in said release liner a frame around a window area (Column 8, Lines 45 – 52; Figure 7, Items 58, 60). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the cuts of Kelly in McKillip's label in order to create a business form with multiple removable labels with a minimal amount of layers.

The modification creates an apparatus wherein removal of said release liner in said frame area exposes said adhesive layer only in said frame area, and

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that removal of said adhesive-backed label exposes an adhesive-free window area in which a message can be seen through a non-opaque release liner.

McKillip modified by Kelly discloses the claimed invention except for the specific arrangement and/or content of indicia (message on the liner) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the liner capable of having indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (indicia) and the substrate (liner) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 22, as applied to Claim 21, McKillip modified by Kelly further discloses that the said frame area is so shaped and dimensioned that when a document is placed between said release liner 54 and the surface of said container 20 while said structure is applied against said surface, said document

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will be sealed against said container but will not adhere to said container nor to said release liner (Figure 7, Item 20, 30, 60; Kelly). The Examiner considers this to be true because the structural makeup is the same and as long as the document does not come in contact with adhesive and only in contact with the liner. The citation for Kelly is very similar to Figure 4B of the application.

In regards to Claims 23 and 24, as applied to Claim 21, McKillip modified by Kelly further discloses wherein a line of weakness 20 is formed in said sheet adjacent said portion of said sheet and said portion of said sheet is separable at said line of weakness from remainder of said sheet (Column 5, Lines 25 – 28; Figure 1, Item 20; McKillip).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The objections to the drawings are withdrawn since applicant has filed the correct drawings.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Thursday 7:00AM - 4:30PM and every other Friday from 7:00AM – 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
May 30, 2007


MONICA CARTER
SUPERVISORY PATENT EXAMINER